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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,464	02/14/2006	Kristofer Olofsson	059490-5048-US	1368
9629 7590 03/17/2008 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER				
BARKER, MICHAEL P				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/563,464

**Applicant(s)**

OLOFSSON ET AL.

**Examiner**

MICHAEL P. BARKER

**Art Unit**

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01/05/2006, Preliminary Amdmt.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

**Claims 1-39** are pending in this Application and subject to a Restriction Requirement.

#### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

#### ***Lack of Unity Requirement***

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. Applicant is required to **elect a single species** to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention (which will be rejoined with the pending compound claims) to which the claims must be restricted:

- **Invention I, Claims 1-39**, drawn to compounds of the formula of **Claim 1** [wherein X is an optionally substituted aryl or heteroaryl group], their compositions, and their methods of use.
- **Invention II, Claims 1-39**, drawn to compounds of the formula of **Claim 1** [wherein X is an optionally substituted amide, amine, or sulfonamide group], their compositions, and their methods of use.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of

an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a). Upon thorough consideration of the claims, the examiner has determined that a lack of unity of invention exists, as defined in Rule 13. PCT Rule 13.1 states that the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). PCT Rule 13.2 states that unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. Annex B, **Part 1(a)**, indicates that the application should relate to only one invention, or if there is more than one invention, inclusion is permitted if they are so linked to form a single general inventive concept. Annex B, **Part 1(b)**, indicates that "special technical features" means those technical features that as a whole define a contribution over the prior art. Annex B, **Part 1(c)**, further defines independent and dependent claims. Unity of invention only is concerned in relation to independent claims. Dependent claims are defined as a claim that contains all the features of another claim and is in the same category as the other claim. The category of a claim refers to the classification of claims according to subject matter, e.g. product, process, use, apparatus, means, etc. Annex B, **Part 1(e)**, indicates the permissible combinations of different categories of claims. **Part 1(e)(i)** states that inclusion of an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product is permissible. Annex B, **Part 1(f)** indicates the "Markush practice" of alternatives in a single claim. **Part 1(f)(i)** indicates the technical interrelationship and the same or corresponding special technical feature is considered

to be met when: (A) all alternatives have a common property or activity, and (B) a common structure is present or all alternatives belong to a recognized class of chemical compounds.

Further defining (B) in Annex B, **Part 1(f)(i-iii)**, the common structure must; a) occupy a large portion of their structure, or b) the common structure constitutes a structurally distinctive portion, or c) where the structures are equivalent and therefore a recognized class of chemical compounds, each member could be substituted for one another with the same intended result.

That is, with a common or equivalent structure, there is an expectation from knowledge in the art that all members will behave in the same way. Thus, the technical relationship and the corresponding special technical feature result from a common (or equivalent) structure that is responsible for the common activity (or property). **Part 1(f)(iv)** indicates that when all alternatives of a Markush grouping can be differently classified, it shall not, taken alone, be considered justification for finding a lack of unity. **Part 1(f)(v)** indicates that when dealing with alternatives, it can be shown that at least one Markush alternative is not novel over the prior art, the question of unity of invention shall be reconsidered, but does not imply that an objection shall be raised.

The claims herein lack unity of invention under PCT Rule 13.1 and 13.2, since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed contain the following technical feature, common to each of the claims: an indole ring, which does not define a contribution over the prior art (variables excluded). Thus, Applicant's technical feature cannot be considered a 'special technical feature' as defined in PCT Rule 13.2, since it fails to define a contribution over the prior art, as it was known in the art prior to the filing of the instant

application.

Applicant is advised that the reply to this requirement to be complete must include an election of an Invention (and election of a species for search purposes) to be examined even if the requirement is traversed (37 CFR 1.143). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Barker whose telephone number is (571) 272-4341. The examiner can normally be reached on Monday-Friday 8:00 AM- 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

/Michael P Barker/

Examiner, Art Unit 1626

/Rebecca L Anderson/

Primary Examiner, Art Unit 1626